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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,744	12/12/2003	Stephen E. Novak	14135US02	9534

23446 7590 01/25/2005

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CHICAGO, IL 60661

EXAMINER
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GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/734,744

Applicant(s)

NOVAK, STEPHEN E.

Examiner

Anthony J. Green

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-21, 23 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 and 13 is/are allowed.
- 6) ☒ Claim(s) 2-6, 8-11, 14, 16-21, 23 and 26-30 is/are rejected.
- 7) ☒ Claim(s) 7 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendments submitted on 07 December 2004. Claims 1, 22 and 24-25 have been cancelled. Currently claims 2-21, 23 and 26-30 are pending. Based on applicants amendments some of the prior art rejections have been overcome however in light of the receipt of translations of the Soviet references used in the last office action, some of the claims previously indicated as being allowable or potentially allowable are now rejected for the reasons that follow.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6, 10, 14, 16, 20-21, 23, and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russian Federation Patent No. 2,130,958.

The reference teaches in the 6<sup>th</sup> full paragraph of page 2 of the translation, the formation of a corrosion safe and non-caking agent for the removal/prevention of ice formations on road surfaces, sidewalks and other surfaces that is based on calcium nitrate and urea. The next paragraph recites that the composition may further contain a corrosion inhibitor, anti-caking additives such as magnesium nitrate, urea formaldehyde polymers, and effect prolonging additives.

The instant claims are obvious over the reference. While the reference does not recite the treatment of aggregates such as coal, it does teach that the composition may be used for treating sidewalks or other surfaces. Accordingly in the absence of evidence to the contrary it would have been obvious to one of ordinary skill in the art to use the composition of the reference to treat any surface in need of ice removal or prevention without producing any unexpected results absent evidence showing otherwise. The use claims 10, 20-21, 23 and 26 are considered to be obvious over the reference. With respect to instant claims 6, 14, 16, and 30 the reference teaches in paragraph 7 on page 2 the addition of a corrosion inhibitor and magnesium nitrate to the composition. As for instant claims 27-29 these limitations are considered to be matters of obvious choice or design best determinable through routine optimization and experimentation in the art and producing no unexpected results as one of ordinary skill in the art would find it obvious to use the agent whenever or wherever it is needed or desired. Accordingly based on the above reasoning the instant claims are rendered obvious by the reference absent evidence showing otherwise.

4. Claims 2-5, 8-11, 16-21, 23, and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russian Patent Certificate No. 302944.

The reference teaches in the claim a composition for prevention of the congealing of loose materials and the elimination of the formation of icing comprising calcium chloride and calcium nitrite-nitrate.

The instant claims are obvious over the reference. While the reference does not teach that the composition is for treating coal or aggregates it does teach that it is used to treat loose materials in order to prevent them from sticking together and icing.

Accordingly it would have been obvious to use the composition on any type of loose material such as coal or aggregates in order to prevent them from icing together absent evidence to the contrary. Thus claims 8-10, 20, 23 and 26 are rendered obvious absent evidence showing otherwise. With respect to the use of an aqueous solution (recited in instant claim 2) the reference teaches on page 2, lines 3-4 that the composition may be applied in a dry state or as a paste or a solution. As for the amount of the salt and corrosion inhibitor (calcium nitrite is taught by the reference) present in the composition (instant claims 2-5, 11, 18-19) the reference teaches in the claim that the combination of calcium nitrite-nitrate is from 10-50 percent therefore the amount of the components are seen to be encompassed by the amount recited in the reference. One of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap or encompass the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of

percentages", In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

As for instant claims 27-29 these limitations are considered to be matters of obvious choice or design best determinable through routine optimization and experimentation in the art and producing no unexpected results as one of ordinary skill in the art would find it obvious to use the agent whenever or wherever it is needed or desired. Accordingly based on the above reasoning the instant claims are rendered obvious by the reference absent evidence showing otherwise.

#### ***Allowable Subject Matter***

5. Claims 12-13 are allowable over the art of record as the prior art fails to teach and/or fairly suggest an aggregate treated with sodium nitrate.


6. Claims 7 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony J. Green  
Primary Examiner  
Art Unit 1755

ajg  
January 24, 2005